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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,399	07/01/2003	Kohichi Katoh	239700US2	9354

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/609,399

Applicant(s)

KATOH ET AL.

Examiner

Janis L. Dote

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-12 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/13/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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1. A request for continued examination (RCE) under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicants' submission filed on Sep. 13, 2006, has been entered.

2. The examiner acknowledges the amendments to claims 1, 6, 18, and 19 set forth in the amendment filed on Jul. 10, 2006, which was entered upon the filing of the RCE. Claims 1-6, 8-12, and 18-20.

3. Claims 8-12 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicants timely traversed the restriction (election) requirement in the reply filed on Jul. 11, 2005.

4. The examiner has crossed out the reference US 2005/0026064 listed in the "List of related cases" in the Information

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Disclosure Statement (IDS) filed on Sep. 13, 2006, because the reference is listed on the form PTO-1449 filed on Sep. 13, 2006, and has already been considered by the examiner.

The examiner has considered US application 11/450,470 listed on the "List of related cases" in the IDS's filed on Sep. 13, 2006..

5. Applicants' arguments filed on Jul. 10, 2006, regarding the submission of the "List of related cases" in the Information Disclosure statement filed on Sep. 23, 2004, have been considered but are deemed to be persuasive.

Applicants submit that the "List of related cases" in the Information Disclosure statement filed on Sep. 23, 2004, was "submitted in a proper manner, since Mr. Nicholas Godici, former Commissioner for Patents, stated on August 4, 2004 that copies of cited pending applications are no longer required. Applicants have satisfied their duty of disclosure by providing this listing to the Examiner. The OG Notice of October 19, 2004 . . . does not state that its effects are not retroactive."

Applicants' arguments are frivolous. The notice expressly states the effective date of the policy: "[t]his waiver is effective immediately." (i.e., Oct. 19, 2004.) No private communication could possibly put the policy into effect prior to

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publication of the notice. Accordingly, for the reasons discussed in the office action mailed on Sep. 15, 2005, page 4, the IDS filed on Sep. 23, 2004, does not comply with the requirements of 37 CFR 1.98, and has not been considered.

6. The rejections of claims 1-6 and 18-20 under 35 U.S.C. 112, first paragraph, set forth in the office action mailed on Feb. 9, 2006, paragraph 6, items (1) and (3), have been withdrawn in response to the amendments to claims 1, 6, 18, and 19 filed on Jul. 10, 2006, which were entered upon the filing of the RCE on Sep. 13, 2006.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-6 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-6 and 18-20 recite "using a TURBULA SHAKER MIXER T2F-10B-50A, manufactured by Willy A. Bachofen AG." The claims

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contain the trademark/trade name TURBULA. See the USPTO Trademark Electronic Search System (TESS) file for the trademark TURBULA, Serial No. 76610326, printed on Sep. 6, 2005, which is listed on the form PTO-892, attached to the office action mailed on Sep. 15, 2005. The specification at page 12, lines 9-11, defines "TURBULA mixer" as a commercially available TURBULA SHAKER MIXER T2F-10B-50A, manufactured by Willy A. Bachofen AG. However, where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a particular mixer and, accordingly, the identification/description is indefinite.

The examiner notes that applicants intend to limit the scope of the claimed subject matter to toner compositions having

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properties after being processed by the particular mixer specified. See the response filed on Jul. 10, 2006, page 10, lines 17-18.

Applicants state that the "claims require that the various values for the above-recited relationship is obtained when using a particular mixer." Applicants allege that the mixer recited in the instant claims was "introduced worldwide in the early 1960's, and is still being sold," as confirmed from the website for the company Willy A. Bachofen AG, which describes that a TURBULA® shaker-mixer is "used for the homogeneous mixing of powdery substances with differing specific weights and particle sizes." Applicants submit that the claims are definite.

Applicants' assertion is not persuasive. The term "TURBULA" shaker-mixer is a registered trademark. As discussed in the rejection above, the claim scope is uncertain since the trademark cannot be used properly to identify any particular product. The trademark is used to identify a source of goods, and not the goods themselves. The same trademark can be used to identify different apparatuses or products associated with the trademark depending on the desire of the owner. The apparatus associated with the trademark at the time the invention was made may not be the same as the apparatus at a later date, and may not be the same apparatus as in the past. The trademark does

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not refer to a definite apparatus and need not be used in association with a particular apparatus. Moreover, "the value of a trademark would be lost to the extent that it becomes descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark . . . in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark . . ." MPEP 2173.05(u). (Rev. 5, Aug. 2006).

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-5 and 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Instant claims 1-5 and 18-20 recite a "carrier being coated with a material such that any portions of the coated material have a thickness in a range of approximately 75% to 125% of an average thickness of the carrier coating" (emphasis added).

The originally filed specification does not provide an adequate written description of the carrier recited in the instant claims. The originally filed specification at page at page 10, lines 4-6, states that "any portions of the coated material have a thickness in a range of from 75% to 125% of the average thickness." In example 2 at page 24, lines 22-25, the originally filed specification states that "it was found by TOF-SIMS that the thickness of the coating of the carrier is in the specific range of from 75% to 125% of the average thickness (specifically the thickness of the coating fell in a range of from 90 to 110%)" (emphasis added). There is no description in the originally filed specification of a carrier coating having a thickness in a range of "approximately 75% to 125% of an average thickness of the carrier coating" as recited in the instant claims. The thickness range "approximately 75% to 125%" is broader than the disclosed thickness range of "75% to 125%" because the term "approximately" admits variation of the endpoints. The recitation "approximately 75% to 125%"

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encompasses thicknesses beyond 75% and 125% of an average thickness of the carrier coating.

Applicants' arguments filed on Jul. 10, 2006, have been fully considered but they are not persuasive.

Applicants assert that the amendment to claim 1 filed on Jul. 10, 2006, renders the rejection moot.

However, for the reasons discussed in the rejection above, the amendment to claim 1 did not overcome the rejection. Accordingly, the rejection of claims 1-5 and 18-20 stand.

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-5 and 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5,380,614 (Totsuka), as evidenced by applicants' admissions at page 8, lines 3-10, and page 14, line 26, to page 15, line 3, of the instant specification (applicants' admission I).

Totsuka discloses a toner. The toner comprises toner particles, whose surfaces comprise surface-treated alumina particles that are fixed to the surfaces and hydrophobic silica particles that are adhered to the surfaces. The surface-treated

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alumina particles are surface-treated with dimethylsilicone and a fluoro-silicone-containing compound. Example 1 at cols. 8-9; and col. 11, lines 66-68. The Totsuka toner meets the toner compositional limitations recited in the instant claims.

Totsuka does not disclose that electrons are "shared" by the external additive and the toner particles as recited in instant claim 3. However, the instant specification at page 14, line 26, to page 15, line 3, discloses that "electron sharing" means "that a portion of the external additive having a volume of about 50% of the total volume of the external additive is embedded into and fixed to the surface portion of the toner particles." In example 1 of Totsuka, the surface-treated alumina particles are first mixed with the toner particles in a HENSCHEL[®] mixer, wherein the alumina particles are adhered to the surface of the toner particles. See Fig. 2(A); col. 6, lines 33-38, and example 1. That composite powder mixture is then placed in a "surface reformer," a Nara hybridization system, where compression force and frictional force are applied to the composite powder mixture such that the alumina particles are fixed to the surface of the toner particles as shown in Fig. 2(B). Col. 6, lines 39-48, and example 1. Fig. 2(B) shows that the surface-treated alumina particles are embedded in the surface of the toner particles. Fig 2(B) appears to show that

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about 50% by volume of the total volume of the alumina particles is embedded in the surface of the toner particle. Accordingly, because the Totsuka surface-treated alumina particles appear to be embedded in the surface of the toner particles in an amount of about 50% by volume of the total volume of the alumina particles, it is reasonable to presume that electrons are being "shared" between the toner particles and the surface-treated alumina particles as recited in instant claim 3. The burden is on applicants to prove otherwise. In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

Totsuka also does not disclose that its toner satisfies the relationship recited in instant claims 1 and 2. However, as discussed above, the Totsuka toner meets the compositional limitation recited in the instant claims 1 and 2. The toner also appears to meet the "electron sharing" limitation recited in instant claim 3. The instant specification at page 8, lines 3-10, discloses that toners that satisfy the relationship recited in the instant claims have good charge properties and durability, and produce good images without causing problems in background fouling and toner scattering. According to Totsuka, its toner has superior charging properties, and provides a large number of images without the problems of increased fog density and toner scattering. Col. 1, line 64, to col. 2, line 2.

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Totsuka discloses that the toner in example 1 exhibited stable charge properties after forming 5,000 copies. That toner also provided 5000 good quality images with stable image density and very little fogging, and with no generation of toner scattering. See Table 1 at col. 12, example 1. These properties appear to be the properties sought by applicants. Accordingly, because the Totsuka toner meets the compositional limitations recited in the instant claims and the toner appears to have the properties sought by applicants, it is reasonable to presume that the Totsuka toner satisfies the relationship recited in instant claims 1 and 2. The burden is on applicants to prove otherwise. Fitzgerald, supra.

Totsuka does not disclose that its toner is used in a developing device that includes a toner replenishing section, such that "the replenished toner composition has substantially a same charge quantity as that of the toner composition . . ." as recited instant claims 4, 5, and 18-20. However, the recitations in claims 4, 5, and 18-20 are merely statements of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use,

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then it meets the claim. As discussed above, the toner disclosed by Totsuka meets the toner compositional limitations recited in the instant claims. Accordingly, the recitation of when the toner is used in a developing device that includes a toner replenishing section recited in instant claims 4, 5, and 18-20 does not distinguish the toner recited in the instant claims from the toner disclosed by Totsuka.

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Totsuka, as evidenced by applicants' admission I, combined with US 5,340,677 (Baba).

Totsuka, as evidenced by applicants' admission I, discloses a toner as described in paragraph 12 above, which is incorporated herein by reference. For the reasons discussed in paragraph 12 above, the toner in example 1 of Totsuka meets the compositional limitations recited in instant claim 6. It is also reasonable to presume that the Totsuka toner satisfies the relationship recited in instant claim 6. The burden is on applicants to prove otherwise. Fitzgerald, supra.

Totsuka discloses a two-component developer comprising its toner and a carrier. Col. 11, lines 66-68. Totsuka does not disclose a carrier as recited in instant claim 6. However,

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Totsuka teaches that "any carrier generally used in electrophotography may be employed." Col. 7, lines 36-38.

Baba teaches a carrier comprising magnetic core particles coated with a resin coating comprising a particular vinyl copolymer and a particular fluoro-containing polymer. The magnetic core particles comprise a binder resin and magnetic particle dispersed in the binder resin. Confirmed by scanning electron microscopy (SEM), Baba discloses that the carrier core particles are "uniformly coated" with the resin coating.

Col. 7, lines 57-60, and example 1 at col. 34, in particular col. 34, lines 53-57. According to Baba, its "carrier . . . requires no replenishment of carrier during running and also gives a superior developing performance and developer lifetime because of the stability of chargeability of toner during running and under variations of humidity." Col. 4, lines 59-68. The carrier has superior impact resistance, electric resistivity, and stability in imparting charge to toner over a long period of time. Col. 7, lines 46-55.

Baba does not explicitly disclose that "any portions of the material located on the carrier have a thickness in a range of from 75% to 125% of an average thickness thereof" as recited in instant claim 6. However, as discussed above, Baba discloses that the carrier core particles in example 1 are "uniformly

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coated" with the resin coating confirmed by SEM. Baba rated the carrier surface of the carrier in example 1 as excellent, "AA." Baba did not report that the resin coating was uneven as reported for the carrier in comparative example 3. Table 2 at cols. 39-40. Accordingly, based on the information disclosed in Baba, it is reasonable to presume that the resin coating on the magnetic core particles in the Baba carrier in example 1 meets the thickness limitation recited in instant claim 6. The burden is on applicants to prove otherwise. Fitzgerald, supra.

It would have been obvious for a person having ordinary skill in the art, in view of the teachings in Baba, to use the Baba carrier as the carrier in the developer disclosed by Totsuka. That person would have had a reasonable expectation of successfully obtaining a developer that has superior developing performance and developer lifetime as disclosed by Baba.

14. Claims 1-5 and 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese Patent 03-116054, as evidenced by Totsuka and applicants' admission I. See the USPTO English-language translation of JP'054 for cites.

JP'054 discloses a toner. The toner comprises toner particles, whose surfaces are treated with negatively chargeable

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hydrophobic silica particles and positively chargeable hydrophobic silica particles. Translation, application Example 2 at pages 10-11. The negatively chargeable hydrophobic silica particles are mixed with the toner particles and then subjected to a surface treatment with a hybridizer, which is manufactured by Nara Kikai Co., for over a five minute period. Accordingly to JP'054, the negatively chargeable silica particles are "firmly adhered" to the surface of the toner particles. Translation, page 5, lines 21-24. The JP'054 toner meets the toner compositional limitations recited in the instant claims.

JP'054 does not disclose that electrons are "shared" by the external additive and the toner particles as recited in instant claim 3. However, the instant specification at page 14, line 26, to page 15, line 3, discloses that "electron sharing" means "that a portion of the external additive having a volume of about 50% of the total volume of the external additive is embedded into and fixed to the surface portion of the toner particles." As discussed above, the negatively chargeable silica particles are first mixed with the toner particles and then the resultant mixture is subjected to a surface treatment with a hybridizer, which is manufactured by Nara Kikai Co., for a period of five minutes. Totsuka disclose that when toner

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particles comprising external particles present on the surface of the toner particles are placed in a "surface reformer," a Nara hybridization system, compression force and frictional force are applied to the toner particles such that the external particles are fixed to the surface of the toner particles as shown in Fig. 2(B). Col. 6, lines 39-48. Fig. 2(B) shows that the external particles are embedded in the surface of the toner particles. Fig 2(B) appears to show that about 50% by volume of the total volume of the external particles is embedded in the surface of the toner particle. Accordingly, because the JP'059 negatively chargeable silica particles on the surface of the toner particles are subjected to a surface treatment with a Nara hybridizer over a five minute period, it is reasonable to presume the negatively chargeable silica particles are embedded in the surface of the toner particles in an amount of about 50% by volume of the total volume of the silica particles and that electrons are being "shared" between the toner particles and the negatively chargeable silica particles as recited in instant claim 3. The burden is on applicants to prove otherwise.

Fitzgerald, supra.

JP'059 also does not disclose that its toner satisfies the relationship recited in instant claims 1 and 2. However, as discussed above, the JP'059 toner meets the compositional

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limitation recited in the instant claims 1 and 2. The toner also appears to meet the "electron sharing" limitation recited in instant claim 3. The instant specification at page 8, lines 3-10, discloses that toners that satisfy the relationship recited in the instant claims have good charge properties and durability, and produce good images without causing problems in background fouling and toner scattering. According to JP'059, its toner exhibits high transfer efficiency as well as favorable fluidity and preservability. The toner provides images without density losses or fog during a continuous copying operation and without toner scattering. Translation, page 12, lines 11-16. JP'059 discloses that the toner in example 2 provided 100,000 images without density loss and without fog, and with no generation of toner scattering. The transfer efficiency of the toner was 93%. Translation, page 11, lines 2-13. These properties appear to be the properties sought by applicants. Accordingly, because the JP'059 toner meets the compositional limitations recited in the instant claims and the toner appears to have the properties sought by applicants, it is reasonable to presume that the JP'059 toner satisfies the relationship recited in instant claims 1 and 2. The burden is on applicants to prove otherwise. Fitzgerald, supra.

JP'059 does not disclose that its toner is used in a

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developing device that includes a toner replenishing section, such that "the replenished toner composition has substantially a same charge quantity as that of the toner composition . . ." as recited instant claims 4, 5, and 18-20. However, for the reasons discussed in paragraph 12 above, which are incorporated herein by reference, the recitations in claims 4 and 5 are merely statements of intended use. As discussed above, the toner disclosed by JP'059 meets the toner compositional limitations recited in the instant claims. Accordingly, the recitation of when the toner is used in a developing device that includes a toner replenishing section recited in instant claims 4, 5, and 18-20 does not distinguish the toner recited in the instant claims from the toner disclosed by JP'059.

15. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP'059, as evidenced by Totsuka and applicants' admission I, combined with Baba.

JP'059, as evidenced by Totsuka and applicants' admission I, discloses a toner as described in paragraph 14 above, which is incorporated herein by reference. For the reasons discussed in paragraph 14 above, the toner in example 2 of JP'059 meets the compositional limitations recited in instant claim 6. It is also reasonable to presume that the JP'059 toner

satisfies the relationship recited in instant claim 6. The burden is on applicants to prove otherwise. Fitzgerald, supra.

JP'059 discloses a two-component developer comprising its toner and a carrier. Example 2. JP'059 does not disclose a carrier as recited in instant claim 6.

Baba teaches advantages of using a carrier comprising magnetic core particles uniformly coated with a resin coating comprising a particular vinyl copolymer and a particular fluoro-containing polymer. The discussion of Baba in paragraph 13 above is incorporated herein by reference.

It would have been obvious for a person having ordinary skill in the art, in view of the teachings in Baba, to use the Baba carrier as the carrier in the developer disclosed by JP'059. That person would have had a reasonable expectation of successfully obtaining a developer that has superior developing performance and developer lifetime as disclosed by Baba.

16. Applicants' arguments filed on Jul. 10, 2006, as applicable to the rejections in paragraphs 12-15 above have been fully considered but they are not persuasive.

Applicants assert that the "state of the external additive present on the surface of the toner of the present invention is different from the states of the external additives in Totsuka

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et al. and in JP'054." Applicants assert that because Totsuka first mixes toner particles with a particulate alumina, "the resultant toner particles have seriously low fluidity" and "it is difficult to uniformly mix a silica with such toner particles . . . [and] at the surface portions of the toner particles near the alumina particle, sufficient energy does not act on the silica particle to adhere the particle to the surface portions." Applicants assert that in the mixing method of JP'054, "[s]ince a negatively charged silica and a positively charged silica are mixed . . . the toner of JP'054 is different from the toner of the present invention." Applicants further assert that the relationship recited in instant claims 1 and 6 cannot be satisfied when mixing is performed under the conditions of JP'054 using a jet mill.

Applicants' assertions are not persuasive because they are mere attorney arguments that are not supported by any objective evidence. The claim language "external additive located on the surface of the toner particles and comprising Si" recited in instant claims 1 and 6 does not exclude the Totsuka alumina particles surface-treated with dimethylsilicone and a fluoro-silicone-containing compound. Nor does the claim language exclude the negatively charged silica particles disclosed by JP'054. Moreover, contrary to applicants' statement, in

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example 2 of JP'054, a hydridizer manufactured by Nara Kikai Co., not a jet mill, is used to surface treat the toner particles with the negatively charged hydrophobic silica particles. See USPTO translation, page 10, lines 19-24. For the reasons discussed in paragraphs 12 and 14, it is reasonable to presume that both the Totsuka toner and the JP'059 toner satisfy the relationship recited in instant claims 1, 2, and 6 and the electron sharing property recited in instant claim 3. Applicants have not provided any objective evidence to show otherwise. Accordingly, the rejections of claims 1-6 and 18-20 in paragraphs 12-15 above stand.

Applicants traverse the examiner's reliance on the disclosure at page 8, lines 3-10, of the specification. Applicants assert that "[i]t is not proper for the examiner to equate qualitative expressions of results, such as 'good images without causing a background . . . ' in the specification . . . with supporting data, in the prior art, to find that the prior art also satisfies the above-recited relationship in Claim 1."

Applicants' traversal is not persuasive. The disclosure at page 8, lines 3-10, of the specification, merely states the objectives of the invention that "to provide a toner which has good charge properties and good durability" In other words, the properties of the instantly claimed toner. The

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examiner is merely using the available evidence of record to determine whether or not it is reasonable to transfer the burden to applicants to distinguish over prior art toners. Such prior art toners are deemed to be the ones that meet all of the expressed structural and compositional limitations in the claims, and that have properties that are consistent with the properties taught by applicants as advantages due to satisfying the relationship recited in instant claims 1, 2, and 6. Patents for compositions of matter are not properly issued for the discovery of a previously unknown or unrecognized property of an old material.

In addition, applicants assert that the recitations, in particular, "the replenished toner composition has substantially a same charge quantity as that of the toner composition which previously exists in the mixing section when the replenished toner composition and the previously existing toner composition reach the regulating member," in instant claims 4, 5, and 18-20 are not statements of intended use, but are functional limitations.

Applicants' assertion is not persuasive. The "charge quantity" of the replenished toner composition when "the replenished toner composition and the previously existing toner composition [in the mixing section] reach the regulating member"

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appears to depend on how the replenishing toner and the existing toner are used or manipulated in the developing device; not on the toner composition recited in the instant claims. The instant claims are directed to a composition, not to a method of using the composition.

Accordingly, for the reasons discussed above and in paragraphs 12-15, the rejections of claims 1-6 and 18-20 stand.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLD

Oct. 28, 2006

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1700